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13 GOOGLE INC.

14  
15 UNITED STATES DISTRICT COURT  
16 NORTHERN DISTRICT OF CALIFORNIA  
17 SAN FRANCISCO DIVISION

18 ORACLE AMERICA, INC.,

19 Plaintiff,

20 v.

21 GOOGLE INC.,

22 Defendant.  
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Case No. 3:10-cv-03561-WHA

**GOOGLE'S RESPONSE TO THE  
COURT'S ORDER REQUESTING CASE  
MANAGEMENT STATEMENTS**

Judge: Hon. William Alsup

Date Comp. Filed: October 27, 2010

Trial Date: October 31, 2011

Pursuant to the Court's September 26, 2011 Order Requesting Case Management Statements (Dkt. 458) ("Order"), Defendant Google, Inc. ("Google") responds as follows:

**I. Factual Background**

On September 29, 2011, Plaintiff Oracle America, Inc. ("Oracle") submitted a case management statement in which it selected the following 26 separate patent claims to be asserted at trial:

- U.S. Patent No. RE38,104: Claims 11, 27, 29, 39, 40, 41.
- U.S. Patent No. 6,061,520: Claims 1, 8, 12, 20.
- U.S. Patent No. 5,966,702: Claims 1, 6, 7, 12, 13, 15, 16.
- U.S. Patent No. 6,910,205: Claims 1, 2.
- U.S. Patent No. 7,426,720: Claims 1, 6, 10, 19, 21, 22.
- U.S. Patent No. 6,192,476: Claim 14.

Per the Order, any claims other than those listed above "will be deemed foregone as to all accused matters." (Dkt. No. 458, at 1.) In response to the Order, and to Oracle's selection of the above-listed claims, Google provides the following statements regarding concession of alleged infringement and, claim by claim, any and all invalidity defenses that Google will assert at trial.

**II. Statement Regarding Concession of Alleged Infringement**

Google does not concede to infringing any of the above-asserted claims.

**III. Selection of Invalidity Defenses**

With Oracle continuing to assert 26 separate patent claims across six unrelated patents, it remains unclear which claims will actually be tried in the jury trial scheduled to start on October 31. What is clear: it will be impossible to try 26 separate claims in the amount of time the Court has allotted for the trial. In light of the large number of remaining patents and claims, however, it is difficult for Google to narrow the number of prior art defenses it may assert at trial. Nevertheless, Google has in good faith narrowed the number of prior art defenses it will pursue so that, for all but one patent, there are three or fewer prior-art-based invalidity defenses per asserted claim (and in the case of the one exception, there are only four).

Specifically, Google may assert the following invalidity defenses at trial.

- 1       • U.S. Patent No. RE38,104
- 2           ○ Claim 11:
  - 3               ▪ Invalid in view of D. Gries, “Compiler Construction for Digital
  - 4               Computers,” John Wiley & Sons, Inc. (1971).
  - 5               ▪ Invalid in view of U.S. Pat. No. 4,571,678 to Chaitin, issued Feb.
  - 6               18, 1986.
  - 7               ▪ Invalid in view of J.W. Davidson, “Cint: A RISC Interpreter for
  - 8               the C Programming Language,” SIGPLAN ‘87 Papers of the
  - 9               Symposium on Interpreters and Interpretive Techniques (1987),
  - 10              and further in view of AT&T, System V Application Binary
  - 11              Interface Motorola 68000 Processor Family Supplement, Prentice
  - 12              Hall Int’l (1990).
- 13           ○ Claim 27:
  - 14               ▪ Invalid in view of D. Gries, “Compiler Construction for Digital
  - 15               Computers,” John Wiley & Sons, Inc. (1971).
  - 16               ▪ Invalid in view of J.W. Davidson, “Cint: A RISC Interpreter for
  - 17               the C Programming Language,” SIGPLAN ‘87 Papers of the
  - 18               Symposium on Interpreters and Interpretive Techniques (1987),
  - 19               and further in view of AT&T, System V Application Binary
  - 20               Interface Motorola 68000 Processor Family Supplement, Prentice
  - 21               Hall Int’l (1990).
- 22           ○ Claim 29:
  - 23               ▪ Invalid in view of D. Gries, “Compiler Construction for Digital
  - 24               Computers,” John Wiley & Sons, Inc. (1971).
  - 25               ▪ Invalid in view of J.W. Davidson, “Cint: A RISC Interpreter for
  - 26               the C Programming Language,” SIGPLAN ‘87 Papers of the
  - 27               Symposium on Interpreters and Interpretive Techniques (1987),
  - 28               and further in view of AT&T, System V Application Binary
  - Interface Motorola 68000 Processor Family Supplement, Prentice
  - Hall Int’l (1990).

○ Claim 40:

- Invalid in view of D. Gries, “Compiler Construction for Digital Computers,” John Wiley & Sons, Inc. (1971).
- Invalid in view of J.W. Davidson, “Cint: A RISC Interpreter for the C Programming Language,” SIGPLAN ‘87 Papers of the Symposium on Interpreters and Interpretive Techniques (1987), and further in view of AT&T, System V Application Binary Interface Motorola 68000 Processor Family Supplement, Prentice Hall Int’l (1990).

○ Claim 41:

- Invalid in view of D. Gries, “Compiler Construction for Digital Computers,” John Wiley & Sons, Inc. (1971).
- Invalid in view of J.W. Davidson, “Cint: A RISC Interpreter for the C Programming Language,” SIGPLAN ‘87 Papers of the Symposium on Interpreters and Interpretive Techniques (1987), and further in view of AT&T, System V Application Binary Interface Motorola 68000 Processor Family Supplement, Prentice Hall Int’l (1990).

○ All asserted claims: Invalid for failure to comply with 35 U.S.C. § 251 (reissue statute).

• U.S. Patent No. 6,061,520

○ Claim 1:

- Invalid in view of B.T. Lewis et al., “Clarity MCode: A Retargetable Intermediate Representation for Compilation,” ACM, IR ’95, 1/95, San Francisco, California, USA (1995).
- Invalid in view of M. Cierniak et al., “Briki: an Optimizing Java Compiler,” IEEE Compcon ’97 Proceedings (1997).
- Invalid in view of Cierniak, and further in view of Lindholm, Java virtual machine Specification, Release 1.0 Beta DRAFT (1995).

○ Claim 8:

- Invalid in view of B.T. Lewis et al., “Clarity MCode: A Retargetable Intermediate Representation for Compilation,” ACM, IR ’95, 1/95, San Francisco, California, USA (1995).
- Invalid in view of M. Cierniak et al., “Briki: an Optimizing Java Compiler,” IEEE Compcon ’97 Proceedings (1997).

○ Claim 12:

- Invalid in view of B.T. Lewis et al., “Clarity MCode: A Retargetable Intermediate Representation for Compilation,” ACM,

1 IR '95, 1/95, San Francisco, California, USA (1995).

- 2       ▪ Invalid in view of M. Cierniak et al., "Briki: an Optimizing Java  
3       Compiler," IEEE Compcon '97 Proceedings (1997).  
4       ▪ Invalid in view of Cierniak, and further in view of Lindholm, Java  
5       virtual machine Specification, Release 1.0 Beta DRAFT (1995).

6       ○ Claim 20:

- 7       ▪ Invalid in view of B.T. Lewis et al., "Clarity MCode: A  
8       Retargetable Intermediate Representation for Compilation," ACM,  
9       IR '95, 1/95, San Francisco, California, USA (1995).  
10      ▪ Invalid in view of M. Cierniak et al., "Briki: an Optimizing Java  
11      Compiler," IEEE Compcon '97 Proceedings (1997).  
12      ▪ Invalid under 35 U.S.C. § 101 ("computer-readable medium" -  
13      carrier wave not patentable)

14      • U.S. Patent No. 5,966,702

15           ○ Claim 1:

- 16           ▪ Invalid in view of U.S. Pat. No. 5,815,718 to Tock, et al., filed  
17           May 30, 1996.  
18           ▪ Invalid in view of U.S. Pat. No. 5,613,120 to Palay, filed Oct. 20,  
19           1994.

20           ○ Claim 6:

- 21           ▪ Invalid in view of U.S. Pat. No. 5,815,718 to Tock, et al., filed  
22           May 30, 1996.  
23           ▪ Invalid in view of U.S. Pat. No. 5,613,120 to Palay, filed Oct. 20,  
24           1994.

25           ○ Claim 7:

- 26           ▪ Invalid in view of U.S. Pat. No. 5,815,718 to Tock, et al., filed  
27           May 30, 1996.  
28           ▪ Invalid in view of U.S. Pat. No. 5,613,120 to Palay, filed Oct. 20,  
29           1994.

30           ○ Claim 12:

- 31           ▪ Invalid in view of U.S. Pat. No. 5,815,718 to Tock, et al., filed  
32           May 30, 1996.  
33           ▪ Invalid in view of U.S. Pat. No. 5,613,120 to Palay, filed Oct. 20,  
34           1994.

○ Claim 13:

- Invalid in view of U.S. Pat. No. 5,815,718 to Tock, et al., filed May 30, 1996.
- Invalid in view of U.S. Pat. No. 5,613,120 to Palay, filed Oct. 20, 1994.

○ Claim 15:

- Invalid in view of U.S. Pat. No. 5,815,718 to Tock, et al., filed May 30, 1996.
- Invalid in view of U.S. Pat. No. 5,613,120 to Palay, filed Oct. 20, 1994.

○ Claim 16:

- Invalid in view of U.S. Pat. No. 5,815,718 to Tock, et al., filed May 30, 1996.
- Invalid in view of U.S. Pat. No. 5,613,120 to Palay, filed Oct. 20, 1994.

• U.S. Patent No. 6,910,205

○ Claim 1:

- Invalid in view of P. Tarau et al., “The Power of Partial Translation: An Experiment with the Clification of Binary Prolog,” ACM Symposium on Applied Computing (1995).
- Invalid in view of P. Magnusson, “Partial Translation,” Swedish Institute of Computer Science Technical Report (T93:5) (Oct. 1993).
- Invalid in view of U.S. Pat. No. 5,842,017, issued on 10/24/1998 to Hookway et al.
- Invalid in view of B.T. Lewis et al., “Clarity MCode: A Retargetable Intermediate Representation for Compilation,” ACM, IR '95, 1/95, San Francisco, California, USA (1995), and further in view of Magnusson.

○ Claim 2:

- Invalid in view of P. Tarau et al., “The Power of Partial Translation: An Experiment with the Clification of Binary Prolog,” ACM Symposium on Applied Computing (1995).
- Invalid in view of P. Magnusson, “Partial Translation,” Swedish Institute of Computer Science Technical Report (T93:5) (Oct. 1993).

- Invalid in view of U.S. Pat. No. 5,842,017, issued on 10/24/1998 to Hookway et al.
    - Invalid in view of B.T. Lewis et al., “Clarity MCode: A Retargetable Intermediate Representation for Compilation,” ACM, IR ’95, 1/95, San Francisco, California, USA (1995), and further in view of Magnusson.
  - U.S. Patent No. 7,426,720
    - Claim 1:
      - Invalid in view of U.S. Pat. No. 6,823,509 to Webb et al., filed Dec. 20, 2000, further in view of U.S. Pat. Pub. No. 2003/0088604 to Kuck et al., filed Nov. 7, 2002, and further in view of M. J. Bach, The Design of the Unix Operating System, Bell Telephone Labs., Inc. (1986).
      - Invalid in view of U.S. Pat. No. 6,405,367 to Bryant et al., filed June 5, 1998, and further in view of U.S. Patent No. 7,313,793 to Traut et al., filed July 11, 2002.
    - Claim 6:
      - Invalid in view of U.S. Pat. No. 6,823,509 to Webb et al., filed Dec. 20, 2000, further in view of U.S. Pat. Pub. No. 2003/0088604 to Kuck et al., filed Nov. 7, 2002, and further in view of M. J. Bach, The Design of the Unix Operating System, Bell Telephone Labs., Inc. (1986).
      - Invalid in view of U.S. Pat. No. 6,405,367 to Bryant et al., filed June 5, 1998, and further in view of U.S. Patent No. 7,313,793 to Traut et al., filed July 11, 2002.
    - Claim 10:
      - Invalid in view of U.S. Pat. No. 6,823,509 to Webb et al., filed Dec. 20, 2000, further in view of U.S. Pat. Pub. No. 2003/0088604 to Kuck et al., filed Nov. 7, 2002, and further in view of M. J. Bach, The Design of the Unix Operating System, Bell Telephone Labs., Inc. (1986).
      - Invalid in view of U.S. Pat. No. 6,405,367 to Bryant et al., filed June 5, 1998, and further in view of U.S. Patent No. 7,313,793 to Traut et al., filed July 11, 2002.
    - Claim 19:
      - Invalid in view of U.S. Pat. No. 6,823,509 to Webb et al., filed Dec. 20, 2000, further in view of U.S. Pat. Pub. No. 2003/0088604 to Kuck et al., filed Nov. 7, 2002, and further in view of M. J. Bach, The Design of the Unix Operating System, Bell Telephone Labs., Inc. (1986).

Invalid in view of U.S. Pat. No. 6,405,367 to Bryant et al., filed June 5, 1998, and further in view of U.S. Patent No. 7,313,793 to Traut et al., filed July 11, 2002.

Invalid under 35 U.S.C. §§ 101/102 (printed matter).

○ Claim 21:

Invalid in view of U.S. Pat. No. 6,823,509 to Webb et al., filed Dec. 20, 2000, further in view of U.S. Pat. Pub. No. 2003/0088604 to Kuck et al., filed Nov. 7, 2002, and further in view of M. J. Bach, The Design of the Unix Operating System, Bell Telephone Labs., Inc. (1986).

Invalid in view of U.S. Pat. No. 6,405,367 to Bryant et al., filed June 5, 1998, and further in view of U.S. Patent No. 7,313,793 to Traut et al., filed July 11, 2002.

○ Claim 22:

Invalid in view of U.S. Pat. No. 6,823,509 to Webb et al., filed Dec. 20, 2000, further in view of U.S. Pat. Pub. No. 2003/0088604 to Kuck et al., filed Nov. 7, 2002, and further in view of M. J. Bach, The Design of the Unix Operating System, Bell Telephone Labs., Inc. (1986).

Invalid in view of U.S. Pat. No. 6,405,367 to Bryant et al., filed June 5, 1998, and further in view of U.S. Patent No. 7,313,793 to Traut et al., filed July 11, 2002.

• U.S. Patent No. 6,192,476

○ Claim 14:

Invalid in view of U.S. Pat. No. 5,412,717 to Fischer, filed May 15, 1992.

Invalid under 35 U.S.C. § 101 (“computer-readable medium” - carrier wave not patentable).

Invalid under 35 U.S.C. §§ 101/102 (printed matter).

Google reserves the right to narrow its list of invalidity defenses if and when Oracle further reduces the number of asserted claims to a manageable number for trial.



1 DATED: October 3, 2011

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